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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,792	07/30/2003	Takeshi Kato	011350-314	9403
21839 7590 01/09/2008 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER LIN, SHEW FEN	
			ART UNIT 2166	PAPER NUMBER
			NOTIFICATION DATE 01/09/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
debra.hawkins@bipc.com

MN

<b>Office Action Summary</b>	<b>Application No.</b> 10/629,792	<b>Applicant(s)</b> KATO, TAKESHI	
	<b>Examiner</b> Shew-Fen Lin	<b>Art Unit</b> 2166	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5, 8, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 8, 13-1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

- a. This action is taken to response to Request for Continued Examination filed on 10/17/2007.
- b. Claims 5, 8, and 13-14 are pending in this Office Action. Claims 5, 8, and 13 are independent claims.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 17, 2007 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "capable of", suggest making an option to perform a functionally but not actually having the software programmed (i.e. configured) to provide that functionality exclusively as supported by the specification. In order to have the remaining limitations fully considered and given complete patentable weight, "configured to" should be used instead of "capable of". Claim 13 is rejected for the same reason.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 13 recites the use of various components and elements that would be reasonably understood by one of ordinary skill in the art to mean software, software based component implementation, or an abstract concept based on software. Examples of components and concepts used in the claim are: a program for controlling, transmitting., and other such terms that are interpreted to mean abstract concepts and software implementations. There are no definitive hardware or physical components associated with these examples in the claims or in the specification.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best functional descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed Cir. 1994).

Merely claiming nonfunctional descriptive material, i.e., abstract ideas stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5, and 13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Chui (US Patent Publication 2002/0021758).

As to claims 5 and 13-14, Chui discloses a file storage device (Fig. 17, paragraph 0050, 0249) that is capable of communicating with a portable terminal (Figs. 4-5, paragraph 0064, a typical client device 120 will be a personal digital assistant), comprising:

a thumbnail image transmitting part for transmitting a thumbnail image for a specified file to said portable terminal in response to a request from said portable terminal (paragraph 0108, transmit image to a client computer, Fig. 18, 240, client device download "thumbnail", Fig. 1, paragraph 0036 );

an enlarged image generating part that is responsive to a request from said portable terminal containing a coordinate of an enlargement reference point of said thumbnail image and an enlarging ratio relative to said thumbnail image, for generating an enlarged image corresponding to said a coordinate of an enlargement reference point of said thumbnail image and enlarging ratio relative to said thumbnail image (abstract, Figs. 2-3, paragraph 0028, 0037, using the displayed image, processing logic identifies a location in the first image [thumbnail]. In one embodiment, the location may be identified by positioning a cursor over the location in the image [a coordinate of an enlargement reference point]. The cursor may be positioned by a user

selecting a particular portion of the first image to be shown at another resolution. For example, a user may wish to see a zoomed-in version of a portion of an image, paragraph 0038, the identification of the location of a curser, such as by, for example, x,y coordinates on a display, paragraph 0039-0041, the resolution level of the second image is selected by the user based on the number of times the user activates or engages a user input mechanism, e.g., the number of mouse clicks the user makes [enlarging ratio corresponding the number of click]); and

an enlarged image transmitting part for transmitting the enlarged image generated by said enlarged image generating part to said portable terminal (Figs. 1-2, paragraph 0044, 0138, when the client zooms in on a part of the image at a specified higher resolution level, only the tiles of data needed to generate the portion of the image to be viewed on the client computer are sent to the client computer).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point

out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chui (US Patent Publication 2002/0021758) in view of Parulski et al. (US Patent Publication 2003/0193603, hereinafter referred as Parulski).

**As to claim 8**, Chui discloses a printing system, comprising:

- a file storage device for storing a file (Fig. 17, paragraph 0050, 0249);
- a printing device communicable with said file storage device; and
- a portable terminal communicable with said file storage device (Figs. 4-5, paragraph 0064, a typical client device 120 will be a personal digital assistant), wherein
  - a file stored in said file storage device is printed by said printing device based on an instruction from said portable terminal;
  - said file storage device including:
    - a thumbnail image transmitting part for transmitting a thumbnail image for a specified file to said portable terminal in response to a request from said portable terminal (paragraph 0108, transmit image to a client computer, Fig. 18, 240, client device download "thumbnail", Fig. 1, paragraph 0036);
    - an enlarged image generating part that is responsive to a request from said portable terminal containing a coordinate of an enlargement reference point of said thumbnail image and



an enlarging ratio relative to said thumbnail image, for generating an enlarged image corresponding to said a coordinate of an enlargement reference point of. said thumbnail image and enlarging ratio relative to said thumbnail image (abstract, Figs. 2-3, paragraph 0028, 0037, using the displayed image, processing logic identifies a location in the first image [thumbnail]. In one embodiment, the location may be identified by positioning a cursor over the location in the image [a coordinate of an enlargement reference point]. The cursor may be positioned by a user selecting a particular portion of the first image to be shown at another resolution. For example, a user may wish to see a zoomed-in version of a portion of an image, paragraph 0038, the identification of the location of a curser, such as by, for example, x,y coordinates on a display, paragraph 0039-0041, the resolution level of the second image is selected by the user based on the number of times the user activates or engages a user input mechanism, e.g., the number of mouse clicks the user makes [enlarging ratio corresponding the number of click]); and

an enlarged image transmitting part for transmitting the enlarged image generated by said enlarged image generating part to said portable terminal (Figs. 1-2, paragraph 0044, 0138, when the client zooms in on a part of the image at a specified higher resolution level, only the tiles of data needed to generate the portion of the image to be viewed on the client computer are sent to the client computer);

said portable terminal including:

a display part for displaying the thumbnail image (Figs. 1, 5, display, Fig.2, 100, Fig. 3, 302, thumbnail) and the enlarged image received from said file storage device (Figs. 1, 5, display, Fig. 2, 210, 220, 230, enlarged images).

Chui does not explicitly disclose a printing system comprising a printing device communicable with said file storage device; and a file stored in said file storage device is printed by said printing device based on an instruction from said portable terminal.

However, it is a well-known and common practice in the art to connect printer device to a computer to print file/images required by the user.

Further, Parulski discloses a printing system (Fig. 6) comprising: a printing device communicable with said file storage device (Fig. 6, 270, 290); and wherein a file stored in said file storage device is printed by said printing device based on an instruction from said portable terminal (Fig. 428, Fig. 9, 516, paragraph 0022, 0050, 0063, user order print).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Chui's disclosure to include printer in the image viewing system as taught by Parulski for the purpose of enables a user to order prints and other photo/image related products using these digital images (paragraph 0022). The skilled artisan would have been motivated to improve the invention of Chui per the above such that the portable phone can be used to produce printout of selected images.

### ***Response to Arguments***

Applicant's arguments with respect to claims 5, 8, and 13-14 have been considered but are moot in view of new grounds of rejection. Refer to the corresponding sections of the claim analysis for details.

***Related Prior Arts***

The following list of prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Watanabe; Mikio, US 7027084 B1, "Image communication system and an apparatus for and a method of processing an image".
- Jogo; Naozumi, US 7209149 B2, "Image cropping and synthesizing method, and imaging apparatus".
- Tanaka, Keisuke, US 20030058256 A1, "Method, apparatus and program for composite image generation".

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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December 31, 2007

Shew-Fen Lin  
Patent Examiner  
Art Unit 2166

  
**HOSAIN ALAM**  
**SUPERVISORY PATENT EXAMINER**